

REMARKS-General

1. The independent claims 3 and 13 are amended to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of Claims 3-8 and 13-17 under 35USC103

2. The Examiner rejected claims 3-8 and 13-17 over Kralik (4,660,831) in view of Ou (5,759,123), but these patents fail to suggest the invention of claims 3-8 and 13-17 as amended above because of the following reasons.

3. Kralik claims an inflatable padded game ball which merely suggests an liner formed of multiple layers. As described in column 3, lines 12 to 24, Kralik merely describes that "As shown in FIG. 6, there is an outer reinforcement layer 24 made of woven fabric, preferably polyester, a **control layer 26 of sheet material, preferably ethylene vinyl acetate**, and an inner reinforcement layer 28 of the same material as outer layer 24", and that "As shown in FIG. 7, **the outer and inner woven reinforcement layers 24 and 28, respectively, are embedded in the middle layer 26**", and that "**This is done immediately after extrusion of middle layer before it has set, by embedding the inner and outer layers 24 and 28 in it through the use of rollers or the like.**" In column 3, lines 33 to 38, Kralik further discloses that "**The middle layer 26 of ethylene vinyl acetate** is preferably composed of 28 percent vinyl acetate and 72 percent ethylene, having a specific gravity of 0.95, elongation of 750 percent at ambient, tensile strength of 2500 pounds per square inch at ambient and a Shore durometer hardness of 86.

4. According to the instant invention, the construction liner for American football comprises a compressed and vulcanized integral liner piece. Practically, a rubber piece and a fabric lining after compressed and vulcanized together, the fabric lining is **integrally united** with the vulcanized rubber so that the vulcanized rubber is filled all around the fabric tissues of the fabric lining to form the integral liner piece. For such integral liner piece, it is a single layer structure. According to its sectional view, only a single layer of fabric tissues integrated with vulcanized rubber but no multiple layers will be found. Such construction liners as claimed in the claim 3 are adapted to be

overlappedly sewn with the cover skins to form the ball cover in order to construct the American football as claimed in claim 13.

5. The Examiner appears to reason that since Kralik discloses a construction liner comprising a fabric lining (24)) and a sheet material (26) **laminated together** and Ou reveals a football **construction** including a panel formed from rubber layer and a fabric lining layer which are compressed and vulcanized together, it would have been obvious to one skilled in the art to the ethylene vinyl acetate sheet of Kralik **with a rubber sheet** that is compressed and vulcanized with the fabric lining to form the liner piece in order to take advantage of rubber's well know physical characteristics and to form an integral line piece.

6. The applicant respectfully submits that Kralik never calls the element 26 as sheet material (it calls middle layer) or the structure of "laminated together". The woven fabric layers are embedded with the middle layer made of ethylene vinyl acetate by rollers. Also, the applicant, Tsung Ming Ou, of 5,759,123 who is the inventor the instant invention has never called the American football of the '123 patent as football **construction** and the term "panel". Indeed, the only mention of the disclosure of "construction", "vulcanization" and "rubber material" is in applicant's own specification and claims. Accordingly, it appears that the Examiner has fallen victim to the insidious effect of a hindsight analysis syndrome where that which only the inventor taught is used against the teacher in W.L. Gore and Associates v. Garlock, Inc., 220 USPQ 303, 312-313 (Fed. Cir. 1983) cert. denied, 469 U.S. 851 (1984). Such hindsight reconstruction is not a permissible method of constructing a rejection under 35 U.S.C. 103. In re Warner and Warner, 154 USPQ 173, 178 (CCPA 1967).

7. Furthermore, "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." Libbey-Owens-Ford v. BOC Group, 4 USPQ 2d 1097, 1103 (DCNJ 1987). While it is permissible to modify a reference's disclosure in the examination of patent applications, such modifications are not allowed if they are prompted by an applicant's disclosure, rather than by a reasoned analysis of the prior art and by suggestions provided therein. In re Leslie, 192 USPQ 427 (CCPA 1977).

8. The applicant respectfully submits that the construction liner of the instant invention is a compressed and vulcanized integral liner piece but not a panel formed from rubber layer and a fabric lining layer which are compressed and vulcanized together as stated in the Examiner's reason of rejection under 35USC103. The construction liner of the instant invention does not comprise any rubber layer and fabric lining layer no matter they are laminated together or embedded together. The Examiner also mis-defines the instant invention in the rejection reason.

9. Also, it is not fair and not responsible to reject the instant invention by altering the terms and description of the cited arts with the terminologies in the instant invention to make the cited arts more related to the subject matters as claimed in the instant invention. Especially, one of the cited arts is a patented invention of the inventor of the instant invention. The Court of Appeal of the Federal Circuit has stated, "[V]irtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983). Thus, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ 2d 1600 (Fed. Cir. 1988).

10. Throughout the description and claims of Kralik, it never mentions the terms of "**compression and vulcanization**". Kralik does not need to do any compression and vulcanization because only rubber material can be vulcanization. Kralik merely discloses multiple layers of woven fabric, preferably polyester, and **ethylene vinyl acetate**. Woven fabric layers and ethylene vinyl acetate can no way be vulcanized. In fact, the woven fabric layers are embedded with the middle layer made of ethylene vinyl acetate by rollers immediately after the extrusion of the middle layer. In addition, Kralik fails to mention any use of rubber material.

11. The applicant respectfully submits that Kralik fails to suggest any construction liner that is in a compressed and vulcanized integral liner piece having only a single layer of fabric tissue with vulcanized rubber filled all around to form a strong and strengthened construction liner structure for sewing with the cover skin for making American football. The distinctive structural features of the instant invention are the vulcanized rubber with fabric integrated to form the single layer of integral lining piece.

In other words, there are no identical or similar patents by other before the instant invention. The issuance of the instant invention will have no conflict with any existing patents.

12. Regarding to the inventor's another patented invention, i.e. the '123 patent, it merely suggests an American football with cover pieces each is made of compressing and vulcanizing rubber skin with fabric pad so as to form a rubber skin provided with protruding peddles thereon. The '123 patent never mentions any construction liner for sewing edge to edge with leather made cover skin. The instant invention is especially important for the inventor to protect the competitors to copy the concept and make construction liners ad claimed in the instant invention for sewing with leather cover skins in manufacturing American footballs.

13. Accordingly, applicant believes that the rejection of claims 3-8 and 13-17 is improper and should be withdrawn. If the Examiner refuses to protect the instant invention simply by such combination of an irrelevant cited art, Kralik, with the inventor's '123 patent, the only beneficiaries will be all the competitors of the applicant of the instant invention that they can simply identically copy the construction liners as claimed in claims 3-8 and make American football as claimed in claims 13-17. It is substantially not fair to the applicant and also violates the original spirit of the US patent system.

14. Applicant believes that neither Kralik nor Ou, separately or in combination, suggest or make any mention whatsoever of the instant invention as recited in claims 3-8 and 13-17.

15. Regarding to the commercial success argument, the Examiner's mere reason is that the applicant has already received several patents directed to very similar embodiments as the one pending. However, what is claimed in this application is not the disclosed invention but is the claimed invention. An invention is protected by claims which can be issued in one patent or various patents. A conception invention can be defined by more than one claims, therefore the applicant may draft more than one independent claims to define the invention in different ways. The claiming subject matter of the instant invention is the "construction liner" which is an independent component for constructing an American football by sewing edge to edge with a cover skin, wherein the skin is generally made of leather or synthetic leather. The applicant

herewith needs the claims (such specific definitions of the invention) as claimed in this application to protect the invention. It is nothing to do with whether the applicant has other patents to claim and define the conception invention in different ways. Based on the Rule 132 Declaration by the inventor as submitted on June 17, 2004, it both rebuts the *prima facie* of obviousness and establishes an important secondary factor of non-obviousness, namely commercial success, the Examiner is requested to reconsider and withdraw the obviousness rejection made against claims 3-8 and 13-17.

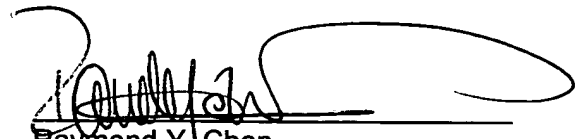
The Cited but Non-Applied References

16. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

17. A signed Declaration under Rule 132 by the applicant is enclosed herewith.

18. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 3-8 and 13-17 at an early date is solicited.

Respectfully submitted,




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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by Express Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

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